## REMARKS

### I. Status of the Claims

Claims 32-69 are pending. No claims have been cancelled. New Claims 66-69 have been added. Claim 35 has been amended to more particularly point out and distinctly claim that which Applicants consider to be their invention. Support for new claims 66-69, as well as for the amendments to claim 35, can be found in the application as filed, for example, at page 4, line 25 to page 6, lines 26. Further, it is believed and intended that the amendments to claims 35 do not narrow the scope of claim 35.

### II. Information Disclosure Statement

The Office has indicated that the Information Disclosure Statement filed November 6, 2000, fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed.

Applicants submit herewith a copy of the date stamped postcard, which indicates that the references were submitted to the Patent Office along with the Information Disclosure Statement filed November 6, 2000. Therefore, Applicants believe that all requirements under 37 CFR § 1.98(a)(2) were met at the time the Information Disclosure Statement was filed. However, Applicants resubmit herewith a copy of the PTO-1449 and the documents for the Examiner's convenience and request that they now be considered.

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**III. Rejection Under 35 U.S.C. § 112**

The Office has rejected claims 35 and 37 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office has stated that the terms "biotechnology and microbiological origin" are broad terms which do not provide any metes and bounds and render the claim indefinite. *See* outstanding Office Action, p. 2. The term "microbiological" is not in claims 35 or 37, and therefore this rejection is moot. Regarding the term "biotechnology", Applicants respectfully traverse this rejection for at least the following reasons.

Applicants realize that the Office is supposed to give each claim its broadest reasonable interpretation. *See* M.P.E.P. § 2111. Applicants respectfully submit, however, that the breadth of a claim is not to be equated with indefiniteness. *See* M.P.E.P. § 2173.04. Examination focuses upon whether the claims convey a reasonable degree of clarity and precision, not whether the claims are broad. *See* M.P.E.P. § 2173.02. A reasonable degree of clarity and precision may be absent, for example, if the broadest reasonable interpretation could have a varying meaning. This is not the case here.

Furthermore, the term "biotechnology" is a well known term of art and the skilled artisan would readily understand its metes and bounds. Therefore, the skilled artisan would readily be able to determine the metes and bounds of claims 35 and 37.

As the rejection based on the breadth of the term "biotechnology" is improper, and as the scope of claims 35 and 37 is definite, Applicants respectfully request that this rejection be withdrawn.

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## IV. Rejection Under 35 U.S.C. § 103(a)

The Office has rejected claims 32-65 under 35 U.S.C. § 103(a) as being unpatentable over PCT No. WO 97/19998 ("Aaslyng") in view of U.S. Patent No. 5,679,903 ("Audousset"), for the reasons provided at pages 3-4 of the Office Action. Applicants respectfully traverse this rejection for the reasons set forth below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claimed limitations. See M.P.E.P. § 2143. Furthermore, motivation must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Applicants claim, among other things, a composition for the oxidation dying of keratin fibers, comprising at least one oxidation dye chosen from heterocyclic oxidation bases, heterocyclic couplers, and acid addition salts of said oxidation dyes; and at least one laccase-type enzyme, provided that said heterocyclic oxidation base is not chosen from 4,5-diamino-6-hydroxy-pyrimidine and 3,4-diaminohydroxy-pyrazole, and provided that said heterocyclic coupler is not chosen from indole, indoline, monocyclic pyridine, and phenazine compounds. *See e.g.,* Applicants' claim 32.

The Office has stated that in view of the teachings of Audousset, one having ordinary skill in the art would be motivated to modify Aaslyng to arrive at Applicants' claimed invention by substituting other dyes with heterocyclic bases and couplers to

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modify different color and shades in the dying of hair. The Office further states that such modification would be obvious because one would expect that the use of heterocyclic oxidation bases and couplers would be similarly useful and applicable to the Aaslyng composition for dyeing hair because they are thought to be functional equivalents by Audousset. *See* Office Action, page 4.

Applicants respectfully disagree with the Offices' alleged motivation for combining Aaslyng and Audousset. While Audousset does list heterocyclic oxidation bases and couplers along with various other oxidation bases and couplers (*see e.g.,* Audousset, column 4, lines 39-44), merely listing such compounds together says little or nothing regarding their equivalency, and certainly does not provide the requisite clear and particular motivation to choose heterocyclic oxidation bases and couplers from among the various other compounds taught by Audousset and combine them with the laccases of Aaslyng.

Furthermore, given that the compositions of Audousset are quite different from those of Aaslyng, the Office's allegations that one having ordinary skill in the art would be motivated to modify Aaslyng by using the heterocyclic bases and couplers of Audousset is tenuous at best. Audousset is directed to a composition for the oxidation dyeing of keratin fibers, comprising at least one coupler selected from indole couplers, and at least one additional heterocyclic coupler. *See* column 2, line 10 to column 3, line 58. Aaslyng, on the other hand, does not teach indole couplers, but rather teaches that the composition may optionally comprise modifiers, such as those listed at page 8, lines 1-12. *Also see* page 7, lines 33-38. Further, Aaslyng is directed to a dyeing

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composition for keratinous fibers comprising one or more oxidation enzymes derived from a strain of the genus Scytalidium. *See* Aaslyng, p. 3, lines 20-31. Audousset, on the other hand, does not disclose oxidation enzymes. Because the compositions of Aaslyng and Audousset are so different, there is no clear and particular motivation to combine the teachings of Aaslyng and Audousset, nor is there any reasonable expectation of success in doing so. At best it would be obvious to try the oxidation bases and couplers of Audousset in the compositions of Aaslyng. However, as the Office is well aware, "obvious to try" is not the standard for determining obviousness. *See* M.P.E.P. § 2145(X)(B). For these reasons alone, the rejection should be withdrawn.

However, for the sake of argument only, even if there was motivation to combine Aaslyng and Audousset, the combination still would not result in Applicants claimed invention because all of the claimed limitations are not met. This is because Audousset requires "at least one coupler selected from indole couplers", so that the skilled artisan would have been motivated to choose at least one indole coupler when applying the teachings of Audousset to Aaslyng. *See* column 3, lines 13-15. Contrary to the teachings of Audousset, Applicants' claimed invention specifically excludes indole compounds as couplers. *See* e.g., claim 32. Therefore, the combination of Aaslyng and Audousset would have led the skilled artisan away from Applicants' claimed invention by teaching that indoles are required. As the Office is well aware, a prior art reference must be considered as a whole, including portions that would lead away from the claimed invention. *See* M.P.E.P. § 2141.02, p. 2100-95, Rev. 1 (Feb. 2000 edition). Therefore, because the Audousset reference, when considered as a whole, requires at

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least one indole coupler, the Aaslyng/Audousset combination would have led the skilled artisan away from Applicants' claimed invention. For this additional reason, the rejection should be withdrawn.

## CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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## APPENDIX

Version of amended claims with markings to show changes made, pursuant to 37 C.F.R. 1.121(c)(1)(ii).

Claim 35 was amended, as follows:

35. (Amended) The composition according to Claim 32, wherein said at least one enzyme of the laccase type is chosen from laccases of plant origin, laccases of animal origin, laccases of fungal origin, and laccases of bacterial origin[,] and laccases obtained by biotechnology.



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